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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/297,399	04/29/1999	MASARU MIYAMOTO	3404/0F546-U	9716

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EXAMINER

SHUSHO, CALLIE E

ART UNIT PAPER NUMBER

1714

DATE MAILED: 11/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/297,399

Applicant(s)

MIYAMOTO, MASARU

Examiner

Callie E. Shosho

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☒ The proposed amendment(s) will not be entered because:  
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ they raise the issue of new matter (see Note below);  
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-2 and 5-9.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
10. ☐ Other: \_\_\_\_\_

Callie E. Shosho  
Primary Examiner  
Art Unit: 1714

**Attachment to Advisory Action**

1. Applicant's amendment filed 10/20/03 has been fully considered. However, the amendment has not been entered given that it raises new issues which would require further consideration.

The use of the phrase "pigment particles having diameter of 500 nm or less" is new and would require further consideration and new searches by the examiner.

Further, as discussed below, it is the examiner's position that the phrase "water-based ink has viscosity of 100 mPas or more" raises new issues under 35 USC 112, first paragraph since there is no support for such recitation in the specification as originally filed.

Specifically, applicant has amended claim 1 to recite that the water-based ink composition has "viscosity of 100 mPas or more". It is the examiner's position that this phrase fails to satisfy the written description requirement under 35 USC 112, first paragraph since there does not appear to be a written description requirement of the cited phrase in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

As support for the recitation that the ink has "viscosity of 100 mPas or more", applicant points to the examples. While it is agreed that the examples disclose inks with viscosity of 115, 186, 195, 326, 218, 405, 383, and 211 mPas, this does not provide support for the recitation that the ink has "viscosity of 100 mPas or more" given that this recitation encompasses inks possessing viscosity of 450 mPas, 500 mPas, 1000 mPas, etc. for which there is no support in the specification as originally filed.

Further, it is noted that the primary reference utilized by the examiner in the rejections of record, namely, JP 6346014, does disclose, in the examples, inks with viscosity of greater than 100 mPas.

**NOTE:** If applicant was to amend claim 1 to recite that the pigment particles "have been subjected to surface treatment with a water-soluble polymer and a surfactant wherein the water-soluble polymer is selected from the group consisting of styrene-acrylic acid resins, styrene-maleic acid resins, polyvinyl alcohol, polyethylene-polyethylene glycol copolymers, alginic acid, and cellulose", the rejections of record would be overcome and withdrawn given that there is no disclosure or suggestion in the "closest" prior art, namely, JP 6346014, Shay et al. (U.S. 5,478,602), and JP 08073787 of pigment which has been subjected to surface treatment with the above recited water-soluble polymers. Support for such amendment is found on page 11, lines 16-21 of the present specification.

It is noted that if applicants were to submit an amendment to incorporate examiner's suggestion as described above, the amendment would be entered even though it is after-final.



Callie E. Shosho  
Primary Examiner  
Art Unit 1714